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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,444	03/26/2004	Sotomitsu Ikeda	02922.000205.	8112
5514 7590 03/19/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
KANE, CORDELLA P				
ART UNIT		PAPER NUMBER		
2132				
MAIL DATE		DELIVERY MODE		
03/19/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/809,444

Applicant(s)

IKEDA, SOTOMITSU

Examiner

CORDELIA KANE

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments and the Amendments, filed February 8, 2008, with respect to the rejections of claims 1 – 10 have been fully considered and are persuasive. However, upon further consideration and a new search necessitated by the new limitations, new grounds of rejection(s) are presented.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Referring to claim 5, applicant claims not printing to the medium if the data has been registered, and also claims printing to the medium if it has been registered. It is unclear which meaning is intended.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1 – 3, 7, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teraura, and further in view of Petteruti et al's US Patent 6,409,401 B1. Referring to claim 1, Teraura teaches:

- a. An identification device that identifies identification information of a recording medium to which the contents information is to be printed (page 1, paragraph 17).
 - b. A second determination device that determines whether or not the contents of the information which is designated for printing has been registered (page 5, paragraph 89 and 92). It is determined whether the ID number of the operator is valid and then stores it.
 - c. A print device that prints the contents information designated for printing to the recording medium based on a determination by the second determination device (page 5, paragraph 92). If the ID number is stored then printing continues.
6. Teraura does not explicitly disclose determining whether or not printing to the recording medium is permitted based on the identification information and inhibiting printing if it is determined that printing is not permitted. However, Petteruti discloses querying the RFID tag address and if the response is not valid then an error occurs and processing is terminated (column 4, lines 59-65, Figure 3). Teraura and Petteruti are analogous art because they are from the same field of endeavor, printing using RFID. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Teraura and Petteruti before him or her, to modify the printing of Teraura to include the verification of Petteruti. The suggestion/motivation for doing so would have been to be sure the address is valid and the tag responds (column 4, lines 61-63).

7. Referring to claim 2, Teraura teaches a management apparatus that controls the contents information printed and the identification of the recording medium (page 5, paragraph 90).

8. Referring to claim 3, Teraura teaches that the determination by the first and second determination devices is carried out in cooperation with the management apparatus (page 5, paragraph 89, 90 and 92).

9. Referring to claim 7, Teraura teaches an information processing apparatus that designates the contents for printing (page 5, paragraph 92).

10. Referring to claim 9, Teraura teaches:

d. The recording medium has a radio section attached thereto (page 5, paragraph 90).

e. The identification apparatus identifies the recording medium by reading the identification information sent from the radio section (page 5, paragraph 92).
For the control circuit to know to select the paper tray with the RFID tag paper in it, it would have to read the RFID.

11. Claims 4, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teraura in view of Petteruti as applied to claim 1 above, and further in view of Tsuboi et al's US Patent 4,958,221. Teraura in view of Petteruti discloses all the limitations of the parent claim as well as printing the information if it has been registered (page 5, paragraphs 89 and 92). Teraura in view of Petteruti does not explicitly disclose the

document not being registered still printing it, and the content information for output already being outputted to the medium. However, Tsuboi discloses:

- f. That the output apparatus still outputs the image even if the image is not registered (column 22, lines 47-52).
 - g. That the content for output has already been outputted (column 23, lines 33-40).
12. Teraura in view of Petteruti and Tsuboi are analogous art because they are from the same field of endeavor, copying and printing. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Teraura in view of Petteruti and Tsuboi before him or her, to modify Teraura in view of Petteruti to include the registration and mosaic method of Tsuboi. The motivation for doing so would have been to print multiple copies of the same image with slightly different color settings so as to be able to locate the one that is the best fit (Tsuboi, column 1, lines 52-67).

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CORDELIA KANE whose telephone number is (571)272-7771. The examiner can normally be reached on Monday - Thursday 8:00 - 5:00 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cordelia Kane/
Examiner, Art Unit 2132

/Gilberto Barron Jr/
Supervisory Patent Examiner, Art Unit 2132